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EXAMINER
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* RODNEY DAUGHTREY

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Appeal 2008-000202  
Application 09/812,224  
Technology Center 3600

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Decided: July 31, 2009

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Before ALLEN R. MACDONALD, *Vice Chief Administrative Patent Judge*,  
and LEE E. BARRETT and LINDA E. HORNER, *Administrative Patent  
Judges*.

HORNER, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Rodney Daughtrey (Appellant) has filed a request for rehearing under 37 C.F.R. § 41.52 requesting that we reconsider our decision of April 8, 2009 (“Decision”), wherein we affirmed the rejection of claims 1-14 under

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35 U.S.C. § 101; affirmed the rejection of claims 1-3, 12-14, and 28-30 under 35 U.S.C. § 102(b); reversed the rejection of claims 4-6, 8, 9, 15-17, 19, 20, 22-27, and 31-38 under 35 U.S.C. § 102(b), reversed the rejection of claims 18, 21, and 39 under 35 U.S.C. § 103(a), and entered new grounds of rejection of claims 15-39 under 35 U.S.C. § 101.

The Appellant argues that the Board:

(1) incorrectly affirmed the § 101 rejection of claims 1-14 because the claimed user interface is tied to a monitor and thus falls within the statutory class of a machine;

(2) incorrectly entered a new ground of rejection under § 101 of method claims 15-18 and 28-35 because these method claims are tied to a particular machine and thus pass the *Bilski* “machine or transformation” test;

(3) incorrectly entered a new ground of rejection under § 101 of computer program product claims 19-27 and 36-39 because the Board’s findings as to the definition of computer readable medium are not supported by the evidence; and

(4) incorrectly affirmed the anticipation rejection of claims 1-3, 12-14, and 28-30 because the Board’s definition of “fares” is inconsistent with industry usage and the usage of the term in the Appellant’s Specification and Claims.

## SUMMARY OF DECISION

We grant the Appellant’s request in part. In light of the Appellant’s arguments presented in the Request for Rehearing, we will modify our

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Decision and withdraw the new grounds of rejection of claims 19-39 under § 101. We will not, however, modify our affirmance of the rejections of claims 1-14 under § 101 and claims 1-3, 12-14, and 28-30 under § 102(b) or our new ground of rejection of claims 15-18 under § 101. Our analysis follows.

### THE INVENTION

The Appellant's claimed invention is directed to a user interface, method, and computer program product for use in travel planning.

### ANALYSIS

#### *Rejection of claims 1-14 under 35 U.S.C. § 101*

In our Decision, we held that user interface claims 1-14 are directed to “an arrangement of information in a table, a clear abstraction.” Decision 5. We further held that the recitation in the preamble of claim 1 that the user interface is “displayed on a monitor” is “simply a statement of intended use” and does not positively recite the monitor so as to place the claimed subject matter within one of the four recognized classes of statutory subject matter. Decision 6-7.

On rehearing, the Appellant argues that claim 1 should be read to be directed to an interface embodied on a monitor, thereby presenting a claim to an interface displayed on a machine. Request 2. The Appellant contends that “the preamble is necessary to give life and meaning to the claim, because by reciting that the monitor displays the novel interface, it transforms the monitor to a novel monitor.” Request 3. The Appellant

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further argues that the monitor is a necessary structural limitation because “without the monitor there would be no interface according to the Board’s own supplied definitions.” Request 3. Further, the Appellant contends that the monitor is more than just a statement of intended use because the body of claim 1 does not fully and intrinsically set forth all of the claim limitations, and the structure of the monitor breathes life into the interface. Request 4.

The Appellant’s arguments are circular. The arguments presume that by claiming a user interface, the claims are directed to an interface displayed on a monitor, and thus the monitor is necessary to effectuate the display. The arguments are based on a definition of user interface that requires an interaction between a user and a computer. Our finding of fact as to the ordinary meaning of “interface”, which the Appellant does not contest, shows that “interface” in the computer science art has two meanings. The Appellant’s arguments fail to address the second meaning, *viz*, “[t]he layout of an application's graphic or textual controls in conjunction with the way the application responds to user activity.” Decision 4-5 (Fact 1, definition (b)).

Our reading of the claim is that it is directed to a layout of data, which is intended to be displayed on a monitor. The monitor, however, is not positively recited in the claim. The Appellant has not persuaded us that we misapprehended or overlooked any facts or law in affirming the Examiner’s rejection of claims 1-14. As such, we will not modify our Decision as to the rejection of claims 1-14 under § 101.

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*Rejection of method claims 15-18 and 28-35 under § 101*

In our Decision, we held that the method of claims 15-18 is not sufficiently tied to a machine because the last step of claim 15, *viz.*, displaying a summary on a user output device, is merely “insignificant extra-solution activity” and does not tie the method to a particular machine.

Decision 11. The Appellant asks us to reconsider this holding and argues:

[T]his step is necessary, unlike a mere storage step, to actually provide the user interface, for without the user interface being somehow rendered or as recited in claim 15, displaying the user interface, the user interface does not exist because as the Board observed in its definition [FF-1] there would not be any point of interaction or communication between a computer and any other entity, nor would there be any layout of an application’s graphic or textual controls in conjunction with the way the application responds to user activity, absent the monitor.

Request 5.

As noted *supra*, our fact finding included one meaning of “interface” as being “[t]he layout of an application’s graphic or textual controls in conjunction with the way the application responds to user activity” (Fact 1, definition (b)). Thus, the broadest reasonable definition of “user interface” refers merely to the abstract layout of information, and does not include or imply the requirement of a computer. The thrust of claim 15 is to the particular layout of information to the user. The step of displaying a summary on a user output device does not impose meaningful limits on the claim’s scope.

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Further, the machine prong of the test described in *Bilski* requires that the method is tied to “a particular machine.” The claim calls for displaying a summary on a “user output device.” The claim does not tie the method to a particular output device, such as a monitor. The phrase “user output device” is a generic term that includes a wide variety of output means including paper. Thus, the Appellant has not persuaded us that the Board misapprehended or overlooked facts or law in entering this new ground of rejection of claims 15-18.

Claim 28, on the other hand, recites a single step of rendering the claimed layout of information on a “monitor.” We agree with the Appellant (Request 5) that this claimed method is sufficiently tied to a particular machine, *viz*, a monitor. As such, we withdraw our new ground of rejection of claims 28-35 under 35 U.S.C. § 101.

*Rejection of computer program product claims 19-27 and 36-39 under § 101*

In our Decision, we adopted a definition of “computer readable medium” based on definitions provided in contemporaneous patents to include signals, such as carrier waves or transmission media, and held that the claims thus encompass patent ineligible subject matter. Decision 14-16. In the Request for Rehearing, the Appellant provided other contemporaneous patents that do not include carrier waves or transmission media in the definition of computer readable medium, and argued that the Board’s definition is not supported by substantial evidence. Request 7.

Upon reconsideration, we realize that our approach to defining “computer readable medium” based on its usage in contemporaneous patents was imprudent. Based on the evidence provided by the Appellant in the Request, it does not appear that “computer readable medium” had any commonly-recognized understanding in the art at the time of Appellant’s invention. As such, we decline to adopt a definition of the phrase “computer readable medium” that broadly includes signals, when the Appellant has clearly stated on the record that he did not intend the phrase to include signals. Request 8 (“Appellant neither actively nor passively sought to encompass ‘transmission medium (or media)’ or ‘carrier wave’ within the meaning of computer readable medium”). Accordingly, we withdraw our rejection of claims 19-27 and 36-39 under 35 U.S.C. § 101.

*Rejection of claims 1-3, 12-14, and 28-30 under § 102(b)*

In our Decision, we held that the Examiner’s interpretation of “fare” to refer to fare price was reasonable in view of the evidence before us. Decision 25. The Appellant argues on rehearing that the Board “overlooked that the claims do not recite a fare, but recite ‘fares.’” Request 9. The Appellant does not, however, explain further how the distinction between “fares,” as opposed to “fare,” changes the outcome of our Decision. We found that Tanner discloses a “table includ[ing] rows representing fares.” Decision 19 (fact 9). “For example, each row represented in the table of Figure 4A represents a fare from Dallas to Frankfurt. These fares include information in each row including the departure and destination cities, the



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fare base price, tax, and fare total price, and the carrier.” *Id.* As such, our findings of fact include a finding that Tanner discloses multiple fares in its table. Although each fare in Figure 4A includes the same departure and destination cities, each fare has a different price, a different carrier, and a different route, and thus each row represents a separate fare.

The Appellant further argues that the Board “avoided consulting Appellant’s specification to clarify the intent of the term ‘fares’ as used by Appellant” and that “Appellant had relied on what the skilled person in the air travel industry would view as the meaning of ‘fares,’ as exemplified by ATPCO.” Request 9 (citing Specification, page 1). Page 1 of Appellant’s Specification states, “Fares and their associated rules are published by airlines and resellers, typically provided through an intermediary such as The Airline Tariff Publishing Company (ATPCO).”

Rather than failing to consult the Appellant’s Specification, the Board, recognizing that the industry understanding of “fares,” as exemplified by ATPCO, was important to our review of the prior art rejections, solicited more information from the Appellant on the usage of this term in the art. *See* Board Order Requesting Supplemental Information, dated June 17, 2008 (noting that the Board does not have access to information published by ATPCO and requesting information regarding the ATPCO database). The information provided by the Appellant did not contain an explicit definition of “fare” and, as laid out in our Decision, contained varied usages of the term “fare.” Decision 24.

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The Appellant argues that “[b]y construing ‘fares’ to merely mean price, instead of the more complicated structure, as disclosed in ATPCO, the Board clearly ignored the distinction that Appellant drew in the specification between ‘fares’ and ‘a fair price.’” Request 9-10. By the “more complicated structure, as disclosed in ATPCO,” we understand the Appellant to be referring to the illustration of a fare record provided in the references supplied by the Appellant (reproduced on page 11 of the Request). This ATPCO fare record includes information on Tariff, CXR, Market, Fare Class, Fare, Effective Date, Link and Seq. No. If we were to adopt this ATPCO fare record as the meaning of “fare,” the definition would not be consistent with the embodiment provided in the Appellant’s Specification. For example, Figure 3 of Appellant’s Specification shows a table that has a column labeled “Fare,” which appears to be a code with information on at least market and airline carrier. It is not clear to us from the evidence on the record that the code 88 in Figure 3 contains all of the information in an ATPCO fare record. For example, we cannot discern whether the code 88 includes information on effective date, link, and seq. no., as exemplified in the ATPCO fare record. We decline to adopt a definition of “fare” that may contradict a preferred embodiment in the Appellant’s Specification. *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1583 (Fed. Cir. 1997) (claim interpretation excluding the preferred embodiment is rarely, if ever, correct and would require highly persuasive evidentiary support). Further, as noted in our opinion, the exemplary ATPCO fare record is not persuasive evidence of what one of ordinary skill

in the art would have understand “fares” to mean, because the ATPCO information provided by the Appellant also uses “fare” elsewhere to refer to fare price or amount. Decision 24 (Facts 6 & 7).

The Appellants contend that “[t]he only proper meaning that the Board should have attributed to the term ‘fares’ would need to include *inter alia* a market and a price, as well as codes.” Request 11. This proposed definition is unsatisfactory because it is open-ended and thus indefinite. It is also not clear what “codes” the Appellant is referring to and how, if at all, this relates to the ATPCO fare record.

The Appellants further contend that “Appellant’s specification treats ‘fare price’ as part of ‘fares.’” Request 13. The Appellant argues that the Board’s definition does not make sense in the context of the claim because “[w]hat possible summary of fare rules could be displayed or determined based on viewing fares as merely a dollar amount.” *Id.* Although the Board defines “fares” as broadly calling for merely a fare price, that fare price has to be associated with additional information about the particular trip segment or flight in order for the fare to have the proper context. For example, Tanner shows “fares” (i.e., fare prices) displayed in rows for a particular market (columns labeled “Dep” and “Dest”) with a particular carrier (column labeled “Al), and with a fare rule summary for each fare (column labeled “Rules”). Tanner, Figs. 4A & 4B. In particular, the first row of Tanner shows a total “fare” for a flight from Dallas Fort Worth (DFW) to Frankfurt (FRA) on US Airlines. *Id.* Thus, Tanner’s fare price is provided in the table in association with corresponding carrier and market

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information, so as to provide the context for the further fare rule summary information in the table.

The Appellant has failed to persuade us that the Board misapprehended or overlooked facts or law in reaching its Decision that the Examiner's interpretation of "fares" is reasonable, and thus in finding that Tanner anticipates claims 1-3, 12-14, and 28-30.

### DECISION

Accordingly, we have granted the Appellant's request for rehearing to the extent that we have reconsidered our Decision, and we have further granted the request to the extent that we have withdrawn the rejection of claims 19-39 under 35 U.S.C. § 101. The request is denied with respect to making any other changes in the decision. Accordingly, the decision to reject claims 1-14 under 35 U.S.C. § 101 is AFFIRMED; the decision to reject claims 1-3, 12-14, and 28-30 under 35 U.S.C. § 102 is AFFIRMED; and the decision to reject claims 4-6, 8, 9, 15-17, 19, 20, 22-27, and 31-38 under 35 U.S.C. § 102 and claims 18, 21, and 39 under 35 U.S.C. § 103 is REVERSED.

We withdraw the new grounds of rejection of claims 19-39 under 35 U.S.C. § 101, and we maintain a new ground of rejection of claims 15-18 under 35 U.S.C. § 101 as being directed to patent ineligible subject matter.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2006).

GRANTED-IN-PART

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